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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,609	03/09/2004	Eiji Kato	FY.51042US1A	1785
20995	7590	06/14/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			WEBB, TIFFANY LOUISE	
2040 MAIN STREET			ART UNIT	PAPER NUMBER
FOURTEENTH FLOOR			3616	
IRVINE, CA 92614				

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/796,609	Applicant(s) KATO ET AL.	
	Examiner Tiffany L. Webb	Art Unit 3616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9,10,15-18 and 21-24 is/are allowed.
- 6) ☒ Claim(s) 1-8,11-14,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/9/2004, 4/3/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner acknowledges receipt of the amendment to the specification submitted on 7/19/2004.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-14 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is unclear to which "front section," in line 3, is being claimed. The preceding claims claim both a "front section of the second group" and a "front section of the first group." The examiner suggests clarifying which front section is being claimed.

Claim 19 is unclear. In lines 2-4, "the frame members that belongs to the second group are spaced apart from each other except for the first and second portions" is unclear to which portions are being claimed. The examiner suggests positively claiming the portions of the frame.

Claim 20 recites the limitation "the another one of the frame members" is unclear to which part is being claimed. The examiner suggests clarifying.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8 rejected under 35 U.S.C. 102(b) as being anticipated by Eastman (US 5,401,056). Regarding claim 1, Eastman discloses an off-road vehicle (10) including: a frame (see Figure 1), a plurality of wheels supporting the frame (24 and 34), and a prime mover powering the wheels (32), the prime mover being mounted on the frame (col. 3, lines 23-25), the frame having a plurality of frame portions (46 and 48) extending adjacent to the prime mover, and at least one of the plurality of frame portions being detachably affixed to the rest of the frame (see Figure 8). Regarding claim 2, Eastman discloses the frame portions surrounding the prime mover (30) on at least three sides

(see Figure 2). Regarding claim 3, Eastman discloses the three sides are lateral sides and a rear side (see Figure 2, 48). Regarding claim 4, Eastman discloses the detachably affixed frame portion is detachably affixed to at least one of the lateral sides (see Figure 8, 52). Regarding claim 5, Eastman discloses the prime mover being an engine (col. 3, lines 25-28, ref. character 32). Regarding claim 6, Eastman discloses the engine having a portion extending generally upward (32), the detachably affixed frame portion being disposed adjacent to the generally upwardly extending portion of the engine (see Figures 1 and 8). Regarding claim 7, Eastman discloses having a motor (32), which is known in the art to have a cylinder and a cylinder head cover which is usually located near the top of a motor, being adjacent to the detachable affixed frame portion (see Figures 1 and 8). Regarding claim 8, Eastman discloses each frame portion is formed with a tubular member (col. 3, lines 38-45) or a generally U-shaped member.

Allowable Subject Matter

8. Claims 9-24 contain allowable subject matter.
9. Claims 11-14 and 19-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to disclose, teach, or suggest having an off-road vehicle including: a frame; a plurality of wheels supporting the frame; and a prime mover powering the wheels; the frame comprising a plurality of frame members, the frame

members being divided into first and second groups, the first and second groups being offset fore to aft relative to each other and overlapping with each other in a rear section of the first group and in a front section of the second group, the rear section of the first group defining a first portion coupled with the second group, and the front section of the second group defining a second portion coupled with the first group.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are all off-road vehicle frames: Gagnon et al. (US 6,523,634), Yoshioka (US 6,595,312), Kosuge (US 4,798,400), Arai et al. (US 4,632,071), and Rasidescu et al. (US 2002/0117843).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tiffany L. Webb whose telephone number is 571-272-2797. The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 571-272-6669. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tiffany L Webb
Examiner
Art Unit 3616

tlw



PAUL N. DICKSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600